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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,411	02/06/2002	Jamie J. McNutt	P99047US2A	4690

7590 10/29/2003

Bridgestone/Firestone Americas Holding, Inc.  
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EXAMINER
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WYROZEBSKI LEE, KATARZYNA I

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 10/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/068,411	MCNUTT ET AL.	
	Examiner	Art Unit	
	Katarzyna Wyrozebski Lee	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on interview 10/23/2003.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                     | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                            | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>0202</u> . | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-5, drawn to composition of a tire component, classified in class 524, subclass 495.
  - II. Claim 16, drawn to method of reducing energy when mixing rubber, classified in class 264, subclass 552.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different invention I is a tire component whereas invention II discloses process for reducing energy, which does not have anything to do tire.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Meredith Palmer on October 23, 2003 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-15. Affirmation of this election must be made by applicant in replying to this Office action. Claim 16 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

9. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the present claims 1-15 following are 112 issues:

Claim 1, lines 2-3 limitation of "absorption of about 45 or less" is indefinite, since it is not clear if the DBP absorption is about 45 or less than 45. Term about also encompasses DBP absorption slightly higher than 45.

Claim 2, line 2 limitation of "iodine number of about 40 or less" is indefinite, since it is not clear if the iodine number is about 40 or less than 40. Term about also encompasses iodine absorption slightly higher than 40.

Claim 4, line 4 contains limitation of "vinyl substituted aromatic" although term vinyl aromatic is definite incorporation of term substituted is not. Use of term substituted allows presence of other substituents as well.

Claim 9, lines 2-3 limitation of "absorption of about 45 or less" is indefinite, since it is not clear if the DBP absorption is about 45 or less than 45. Term about also encompasses DBP absorption slightly higher than 45.

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Claim 10, line 2 limitation of "iodine number of about 40 or less" is indefinite, since it is not clear if the iodine number is about 40 or less than 40. Term about also encompasses iodine absorption slightly higher than 40.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by LAUBE (US 5,426,147) in view of evidence in KITAHARA (US 4,525,541).

The prior art of LAUBE discloses rubber composition used in tire inner liners comprising large sized carbon black and rubber among other conventional additives.

The carbon blacks of the prior art of LAUBE are numbered 1\*, 2\* and 3\* and are described in Table I in col. 5. The DBP values of carbon blacks 1\* and 3\* are 39.1 and 29.1 respectively. The iodine values for carbon black 1\* and 3\* are 16.5 and 27.6 respectively. These carbon blacks are utilized in examples 7, 8, 11 and 12 as depicted in Table III in col. 5-6. The resulting Mooney viscosities of these compositions are 74.2, 77.2, 65.5 and 68.4 for examples 7, 8, 11 and 12 respectively.

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In addition to bromobutyl rubber in Table II (col. 5) the rubbers that are disclosed in col. 2 of the specification of LAUBE include SBR (lines 15-24), polybutadiene, polyisoprene and copolymers thereof.

The amounts of the carbon black in addition to 90 and 100 parts disclosed in Table II is also described as a range of 10-200 parts by weight of rubber in col. 2, lines 25-26 of the specification of LAUBE.

Although the prior art of LAUBE discloses different part of a tire made from the prior art composition, one of ordinary skill in the art would also know that other parts such as bead filler could also be made from the same composition as evidenced in the col. 5, lines 3-6 of the cited disclosure of KITAHARA.

In the light of the above disclosure, the prior art of LAUBE anticipates the requirements of claims rejected above.

In December 2003 US Patent and Trademark Office will be changing its location and as a result phone numbers will change. The new phone number for the examiner of record will be 571-272-1127.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski Lee whose telephone number is (703) 306-5875. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
Katarzyna Wyrozébski Lee  
Primary Examiner  
Art Unit 1714

October 23, 2003